

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Appl. No. : 10/004,511
Applicant : Shannon Morris
Filed : October 22, 2001
TC/A.U. : 3728
Examiner : Luan Kim Bui

Docket No. : 0SSV-083441
Customer No. : 30764

PETITION UNDER 37 C.F.R. § 1.181

Commissioner of Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

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Sir:

Applicant hereby petitions under 37 C.F.R. § 1.181 from the *Examiner's Answer*, mailed February 6, 2004, on the ground that the Examiner, in effect, has entered a new ground of rejection on appeal of the rejection of claims 8-11.

Specifically, the *Examiner's Answer* reveals that the Examiner is rejecting claims 8-11 over a prior art reference based on an interpretation of claim language that is inconsistent with the interpretation of the same claim language that the same Examiner used in allowing a parent application over the same reference.

Applicant was misled by the Examiner's allowance of the parent application to assume that the Examiner would use the same interpretation in the present application.

Despite Applicant's best efforts to understand the Examiner's rejection of claim 8 in the present application, the Examiner only divulged his inconsistent interpretation of the claim language in the *Examiner's Answer*. As a result, Applicant was not given a

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fair opportunity to address the issue and has been denied her administrative due process rights.

By this petition, Applicant seeks to require the Examiner to reopen prosecution so that Applicant can address the Examiner's changed claim interpretation that has now been divulged for the first time in the *Examiner's Answer*.

BACKGROUND

The present application is a continuation of application Serial No. 08/766,862, filed December 13, 1996, now U.S. Patent No. 6,334,530 ("the '530 patent"). Both the parent application and the present application have been examined at every stage by the same examiner, Examiner Luan K. Bui. (See Declaration of Gary A. Clark annexed hereto, "Clark Decl.", ¶ 2.) The claims on appeal are claims 8-11. Claim 8 is an independent claim, and claims 9-11 depend, directly or indirectly, from claim 8.

The invention claimed in both applications relates to a jewelry organizer for holding jewelry such as rings, earrings, drop earrings, watches, bracelets, necklaces, and other strands of jewelry. In general, the invention resides in a jewelry organizer comprising a body having an upper surface and a lower surface, and a knob protruding upwardly from the body and extending above the upper surface. The knob has a diameter and height capable of receiving at least one finger ring over the knob, and there is at least one compartment formed in the upper surface of the body for receiving jewelry. The compartment is defined as an elongated channel sized to receive a piece of jewelry.

In a further aspect of the invention, the jewelry organizer may include an outer rim around the periphery of the body with a surface to allow space for jewelry to be displayed thereon. The outer rim may include a lip which is sized to receive a hook of a drop earring thereon.

In addition, the jewelry may further include a recess formed in the lower surface to enable a stackable configuration with a second jewelry organizer having a knob and at least one compartment. The jewelry organizer may be stacked such that space is maintained between the stacked jewelry organizers to allow jewelry to be placed in the compartment of the second jewelry organizer.

In the parent application, Applicant appealed to the Board of Patent Appeals and Interferences from Examiner Bui's final *Office Action*, mailed July 10, 1998, rejecting claims 1-17 under both 35 U.S.C. § 112, second paragraph, as allegedly indefinite, and 35 U.S.C. § 103, as allegedly obvious. In the *Decision on Appeal*, dated September 29, 2000, the Board reversed Examiner Bui's indefiniteness rejections of claims 1 and 4-17 and his obviousness rejections of claims 1-17. (Clark Decl., ¶ 3 and Exh. A.) However, the Board affirmed the indefiniteness rejection of claims 2-3 and entered a new ground of rejection against independent claims 1 and 8 as allegedly anticipated by U.S. Patent No. 5,040,681 to Grusin, pursuant to 37 C.F.R. § 1.196(b). (*Id.*)

Grusin (Exh. B to Clark Decl.) discloses a desk organizer for storing articles having stackable storage trays. It includes a cover with an enlarged knob-like projection having an aperture formed therein so that the user can insert a finger to grip the cover for placing it on and off the top storage tray.

On remand, following a *Decision* on petition overturning Examiner Bui's holding that Applicant had abandoned the parent application, Applicant filed an *Amendment*, dated April 19, 2001, in which she amended claim 8 of the parent application as follows:

8. (Twice amended) A jewelry organizer for holding jewelry such as rings; earrings, drop earrings, watches, bracelets, necklaces, and other strands of jewelry, comprising:

a body having an upper surface and a lower surface;

a knob protruding upwardly from the upper surface,
**the knob having a diameter and height capable of
receiving at least one finger ring over the knob;**

at least one compartment formed in the upper
surface of the body for receiving jewelry, each
compartment defined as an elongated channel sized to
receive a piece of jewelry;

a recess in the lower surface of the body; and

an outer rim around the periphery of the outermost
compartment.

(Clark Decl., ¶ 5 and Exh. C, p. 2 and attachment.)

In remarks accompanying the *Amendment*, Applicant stated as follows:

. . . claim 8 has been amended to distinguish over Grusin
by requiring that the knob have a diameter and height
capable of receiving at least one finger ring over the knob.
Grusin's knob 30 is much too large to receive such a ring,
and there would be no motivation to make the knob small
enough for that task since it must be large enough to grasp
and also to have an aperture to permit the insertion of a
finger through the center of the knob.

(*Id.*, Exh. C, p. 5.)

The above amendment to claim 8 in the parent application and
accompanying remarks resulted in allowance of the application. (Clark Decl., ¶ 6 and
Exh. D.) The parent application issued as the '530 patent. (*Id.*)

In the present application, filed as a continuation of the parent
application, Applicant presented a broadened claim 8 as follows:

8. A jewelry organizer for holding jewelry such as
finger rings, earrings, drop earrings, watches, bracelets,
necklaces, and other strands of jewelry, comprising:

a body having an upper surface and a lower surface;

a knob protruding upwardly from the upper surface having a diameter and height capable of receiving at least one ring over the knob; and

at least one compartment formed in the upper surface of the body for receiving jewelry and defined as an elongated channel sized to receive a piece of jewelry.

(Clark Decl., ¶ 7 and Exh. E, p. 9.) Claim 8 of the present application differed from allowed claim 8 of the parent application in omitting the word "finger" before "ring", and in not requiring a recess in the lower surface of the body, or an outer rim around the periphery of the outermost compartment.

In a first *Office Action*, mailed May 2, 2002, Examiner Bui rejected claim 8 as allegedly anticipated by Grusin. (Clark Decl., ¶ 8 and Exh. F, p. 4.) Examiner Bui asserted without explanation that "[t]he knob of Grusin is inherently capable of receiving at least one ring over the knob (Figures 1-5)." (Id.)

In an *Amendment*, dated August 30, 2002, Applicant amended claim 8 to limit the "ring" to a "finger ring" as follows:

8. (Amended) A jewelry organizer for holding jewelry such as finger rings, earrings, drop earrings, watches, bracelets, necklaces, and other strands of jewelry, comprising:

a body having an upper surface and a lower surface;

a knob protruding upwardly from the upper surface having a diameter and height capable of receiving at least one finger ring over the knob; and

at least one compartment formed in the upper surface of the body for receiving jewelry and defined as an elongated channel sized to receive a piece of jewelry.

(Clark Decl., ¶ 9 and Exh. G, pp. 5 and 17.)

In remarks accompanying this *Amendment*, Applicant disputed whether the knob of Grusin is inherently capable of receiving at least one finger ring over the knob. Referring to the prosecution of the parent application, Applicant asserted generally as to Examiner Bui's reliance on Grusin as follows:

Applicant respectfully asserts that this characterization is at odds with the disclosure of the Grusin patent, as well as, the Examiner's previous actions. *See* MPEP 704.01, 706.04 ("In general, an examiner should not take an entirely new approach or attempt to reorient the point of view [of a previous examiner] . . .") In an Amendment dated April 19, 2001, Applicant made two amendments to the application. Applicant amended . . . claim 8 to include "the knob having a diameter and height capable of receiving at least one finger ring over the knob", and Applicant further asserted:

Grusin's knob 30 is much too large to receive such a ring, and there would be no motivation to make the knob small enough for that task since it must be large enough to grasp and also to have an aperture to permit the insertion of a finger through the center of the knob.

In response, the Examiner properly allowed all claims. As mentioned above, Grusin's cover 18 has neither . . . nor a knob capable of receiving at least one finger ring, and there is no motivation to modify Grusin's cover 18 in such a manner. Moreover, Applicant respectfully asserts that no basis has been provided to support this new point of view.

(Clark Decl., Exh. G, pp. 8-9.)

In that *Amendment*, Applicant went on to specifically address Examiner Bui's rejection of independent claim 8 as allegedly anticipated by Grusin, stating:

The Grusin patent fails to disclose, or even suggest, a jewelry organizer having all of the features of

independent claim 8, including a knob having a diameter and height capable of receiving at least one finger ring over the knob. In contrast, the aperture 54 of Grusin's knob 30 must be sufficiently sized to allow a finger to pass through and grasp one of the post members. Thus, sizing the knob small enough to receive a finger ring would be inherently incompatible with the intended operation of Grusin's organizer.

(Clark Decl., Exh. G, pp. 10-11, original emphasis.)

In a second *Office Action*, mailed October 30, 2002, which Examiner Bui erroneously designated "final", Examiner Bui again rejected claim 8 as allegedly anticipated by Grusin, asserting that "[t]he knob of Grusin is inherently capable of receiving at least one finger ring over the knob (Figures 1-5)." (Clark Decl., ¶ 10 and Exh. H, p. 4.) Despite Applicant having pointed out to Examiner Bui that he apparently was taking a new position concerning Grusin, Examiner Bui offered no explanation whatsoever of his inconsistent position. (*Id.*)

After convincing Examiner Bui that his second *Office Action* was not properly "final", he reissued it. (Clark Decl., ¶¶ 10-11 and Exh. I.) In response, Applicant filed an *Amendment*, dated April 29, 2003, in which Applicant demonstrated at length how the knob on the cover in Grusin was incapable of receiving a ring finger over the knob. (*Id.*, ¶ 12 and Exh. J, pp. 13-15.) As a result of this *Amendment*, Examiner Bui issued a third *Office Action* containing a restriction requirement, to which Applicant responded by *Amendment*, dated July 31, 2003. (*Id.*, ¶ 12.)

Examiner Bui then issued a fourth and final *Office Action*, mailed September 2, 2003, in which he again rejected claim 8 as allegedly anticipated by Grusin, yet again asserting that "[t]he knob of Grusin is inherently capable of receiving at least one finger ring over the knob (Figures 1-5)." (Clark Decl., ¶ 13 and Exh. K, p. 2.) In response to Applicant's arguments that Grusin was incapable of receiving a ring finger over the knob, all that Examiner Bui stated was "Applicant's arguments with

respect to the rejected claims are noted. They are not persuasive because the ring is not positively claim [sic] with the organizer." (*Id.*, Exh. K, p. 4.)

Applicant then filed a *Request for Interview for Reconsideration of Final Rejection*, dated October 29, 2003, in which Applicant (1) reiterated her position regarding Grusin, (2) addressed the doctrine of anticipation by inherency, and (3) pointed out that her invention is not the combination of a jewelry organizer and a ring, but rather a jewelry organizer sized and configured for rings and other types of jewelry (Clark Decl., ¶ 14 and Exh. L, pp. 1-3.) Applicant even attached a drawing illustrating why Grusin was incapable of receiving a ring finger over the knob. (*Id.*, Exh. L, pp. 6-7.)

A brief and unproductive telephone interview followed on November 4, 2003. Applicant accurately summarized the interview in an *Interview Summary*, dated November 5, 2003:

The undersigned reiterated Applicant's position that claims 8-11 should be allowed for the reasons stated in the *Request for Interview for Reconsideration of Final Rejection*, dated October 29, 2003. The Examiner did not respond to any of those reasons, but simply stated his belief that claims 8-11 were the same claims that had been the subject of the appeal in the parent application, Ser. No. 08/766,862. In response to Applicant pointing out that this was incorrect, the Examiner stated his belief that claims 8-11 were at least similar to the appealed claims and indicated that the rejections would stand.

(Clark Decl., ¶ 15 and Exh. M.) At the same time, Applicant filed her *Notice of Appeal*. (*Id.*)

Examiner Bui then issued an *Advisory Action*, mailed November 6, 2003, denying Applicant's request for reconsideration, and stating again that the application was not in condition for allowance, allegedly because:

. . . the knob of Grusin . . . is inherently capable of receiving at least one finger ring. The Examiner is unpersuasive [sic] for the same reasons as stated in the final rejection during the interview with the applicant's representative on 11/04/03.

(Clark Decl., ¶ 16 and Exh. N, p. 2.) This does not correctly summarize what Examiner Bui stated during the interview, but it is correct insofar as it makes clear that Examiner Bui did not reveal to Applicant the grounds for rejecting claims 8-11 that Examiner Bui would later assert in the *Examiner's Answer* on appeal. (Id.)

Thereafter, Applicant filed *Appellant's Brief*, dated January 5, 2004. (Clark Decl., ¶ 17 and Exh. O.) In her brief, Applicant presented the same arguments about the knob of Grusin being incapable of receiving a finger ring that Applicant has been making since the remand from appeal in the parent application. (Id., Exh. O, pp. 3-6.)

In the *Examiner's Answer*, mailed February 6, 2004, Examiner Bui asserts for the first time a completely different interpretation of the language of claim 8 than he necessarily used in allowing claim 8 of the parent application. Examiner Bui asserts in the *Examiner's Answer* that "(the word [over] is defined as In or at a position above or higher than; Upon the surface of; Above the top or surface; . . ." (Clark Decl., ¶ 18 and Exh. P, p. 4.) Based on this definition, Examiner Bui now attempts to justify his rejection of claim 8 by asserting:

The knob of Grusin is inherently capable of receiving the at least one finger ring over the knob on the planar top surface since the claim as broadly recited read [sic] on the at least one finger ring placed on the planar top surface of the knob/over the knob [sic].

(Id.)

Examiner Bui also asserts for the first time in the *Examiner's Answer* that "the knob [of Grusin] is inherently capable of receiving an oversize finger ring

over the knob . . ." (Clark Decl., ¶ 18 and Exh. P, p. 4, emphasis added.) Although this is also a new argument by Examiner Bui, Applicant does not rely on it as a basis for this Petition. Applicant is confident that the Board would appreciate that there is no such thing as an "oversize" finger ring, *i.e.*, a finger ring having such a large hole through the center that it could be received over the knob of Grusin. What Examiner Bui refers to as an oversize finger ring could be more aptly characterized as a large hoop earring or a bracelet.

ARGUMENT

An examiner is not permitted to enter a new ground of rejection on appeal in an examiner's answer. 37 C.F.R. § 1.193(a)(2). The ultimate criterion of whether a rejection is considered "new" is whether the applicant has had fair opportunity to react to the thrust of the rejection. See In re Kronig, 539 F.2d 1300, 1302 (C.C.P.A. 1976) (construing prohibition of new ground of rejection by Board of Appeals under 37 C.F.R. § 1.196(b)). "It is clear that an applicant must be permitted to respond to a position assumed by the examiner or the board." In re Eynde, 480 F.2d 1364, 1370 (C.C.P.A. 1973).

If at the time of preparing the answer to an appeal brief, an examiner decides to apply a new ground of rejection against some or all of the appealed claims, the examiner should reopen prosecution. MPEP § 1208.01. This, of course, requires supervisory approval. Id.; MPEP § 1002.02(d). An allegation that an examiner's answer contains an impermissible new ground of rejection is waived if not timely raised by way of a petition under 37 C.F.R. § 1.181(a). MPEP § 1208.01.

Applicant is mindful that "[w]here the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection." MPEP 1208.01, citing In re Kronig, supra, 539 F.2d at 1303 (reliance upon fewer references in affirming a rejection under

35 U.S.C. § 103 does not constitute a new ground of rejection). However, the present case involves an unusual situation.

In the parent application, Examiner Bui accepted the claim language "the knob having a diameter and height capable of receiving at least one finger ring over the knob" as distinguishing Grusin. In the continuation application, however, Examiner Bui refused to accept this same claim language as distinguishing Grusin. Although it may be permissible for Examiner Bui to change his mind, it was incumbent on Examiner Bui as a matter of fairness to clearly inform Applicant of his change.

The MPEP instructs examiners to always clearly explain their rejections, and even to suggest amendments to overcome them. See MPEP § 707 ("In rejecting claims for want of novelty or for obviousness, . . . [t]he pertinence of each reference, if not apparent, must be clearly explained . . . , " emphasis added.); MPEP § 707.07(d) ("The examiner should, as a part of the first Office action on the merits, . . . suggest any way in which he or she considers that rejected claims may be amended to make them allowable."). This is even more critical where, as here, the Examiner asserts a position that is inconsistent with his prior interpretation of the same claim language in a parent application.

Unless and until Examiner Bui informed Applicant that he had changed his mind about the interpretation of the claim language, Applicant had every right to assume that Examiner Bui was using the same interpretation and was instead basing his rejection on the ground he actually stated:

Applicant's arguments with respect to the rejected claims are noted. They are not persuasive because the ring is not positively claim [sic] with the organizer.

(Clark Decl., Exh. K, p. 4.)

In Applicant's view, Examiner Bui's refusal to consider the reference to the finger ring as a limitation on the size of the knob was improper, and Applicant so argued in her *Request for Interview for Reconsideration of Final Rejection*. (Clark Decl., Exh. L, p. 3.) This was followed by the telephone interview in which Examiner Bui mistakenly asserted as justification for rejecting claims 8-11 that they were the same as, or at least similar to, the claims that the Board had rejected on the appeal in the parent application. (*Id.*, Exh. M.)

It never occurred to Applicant's undersigned attorney that Examiner Bui was interpreting the claim language differently from the interpretation he necessarily used in allowing claim 8 of the parent application, and Examiner Bui never even hinted that this was the basis for his rejection of claims 8-11 in the present application. (Clark Decl., ¶ 18.) In fact, for all Applicant knows, Examiner Bui did not have his different claim interpretation in mind up to the time of the interview, but arrived at it as an afterthought in the process of answering *Appellant's Brief*. Either way, Examiner Bui's failure to inform Applicant of the Examiner's new claim interpretation denied Applicant a fair opportunity to react to the thrust of the rejection now asserted in the *Examiner's Answer*.

As far as Applicant is aware, the present case is unique on its facts. However, Applicant submits it is analogous to cases such as *In re Wiechert*, 370 F.2d 927 (C.C.P.A. 1967). In *Wiechert*, the court held that "when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing vis-à-vis such portion of the reference." 370 F.2d at 933. That is essentially what Examiner Bui has done here. Examiner Bui has shifted the issue from whether the inherent width or breadth of the knob in *Grusin* knob renders it inherently incapable of receiving at least one finger ring over the knob, to whether the knob has a planar top surface on which a finger ring could be placed. To reveal this shift for the first time in the *Examiner's Answer* is a denial of Applicant's due process rights.

CONCLUSION

For all of the foregoing reasons, Applicant requests that the Examiner be required to reopen prosecution so that Applicant can address the Examiner's new claim interpretation, and be allowed the opportunity to possibly amend the rejected claims.

Dated: February 18, 2004

Respectfully Submitted,

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By: _____

Gary A. Clark

Registration No. 28,060

333 South Hope Street, 48th Floor
Los Angeles, California 90071
Telephone: (213) 620-1780
Facsimile: (213) 620-1398